

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: John N. DODGEN
SERIAL NO. : 10/680,672
FILED : October 7, 2003
TITLE : METHOD OF CREATING AN AUDIO/VIDEO
PRESENTATION FOR FUNERALS
Group/A.U. : 2611
Examiner : Thuy-Vi Thi Nguyen
Conf. No. : 5448
Docket No. : P06686US0

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of claims 1-5 dated October 3, 2007.

I. Real Party In Interest:

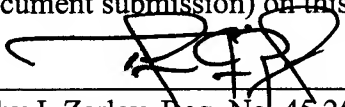
The real party in interest of the instant appeal is John N. Dodgen, an individual, having an address of Highway 169 North, PO Box 39, Humboldt, Iowa 50548.

II. Related Appeals and Interferences:

There are no related appeals or interferences.

Certificate of Electronic Transmission

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office via EFS-Web (United States Patent and Trademark Office's web-based patent application and document submission) on this 5th day of December 2007.



Timothy J. Zarley, Reg. No. 45,253

III. Status of the Claims:

Presently, claims -5 are pending in this application and appear as Appendix A of this brief. Claims 1-5 are identified as the appealed claims.

IV. Status of Amendments:

None

V. Summary of Claimed Subject Matter:

Claim 1 is directed to a method of celebrating a person's life by attendees at a funeral after the person's death, comprising the steps of causing the person, while alive, to create a message presentation that would welcome the attendee to the person's funeral and include personal comments to the attendee in a generally uplifting sense about the occasion of the funeral (page 3, lines 30-32; page 4, lines 15-20), storing the message presentation with instructions that the message presentation be played at the person's funeral (page 4, lines 8-13), and publicly playing the message presentation at the person's funeral for the attendees at the funeral to see and hear (page 4, lines 14-17).

Claim 2 adds the limitation of the message presentation being projected on a screen (page 3, lines 15-21). Claim 3 adds the limitation of the message presentation being an audio presentation (page 3, lines 22-28). Claim 4, which depends from claim 2, adds the further limitation of the message presentation being a combination video-type and audio presentation (page 3, lines 8-11). Finally, claim 5 adds the limitation of the message presentation being an audio/video presentation (id.).

VI. Grounds of Rejection to be Reviewed on Appeal

The Examiner has rejected claims 1-5 under 35 U.S.C § 102(b) as anticipated by US Pat App No. 2002/0072925 by Krim ("Krim").

VII. Argument

1. Rejection under 35 U.S.C. § 102(b)

Claims 1-5

Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharms., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing In re Robertson, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)).

"The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention." Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG

Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Applicant believes that Examiner herein has misperceived certain fundamental aspects of the Krim disclosure. Applicant's claim 1 requires, in pertinent part, the creation by person of a message during life, that the message be stored, and that the message be publicly played at the person's funeral. Krim does not teach these limitations.

At pages 2 and 4 of the Final Office Action dated October 3, 2007, Examiner suggests that Krim ¶¶ 0063-0064 teach that it is the decedent's audio-visual message that is presented at the funeral. Applicant disagrees, and believes that the Examiner has misplaced reliance on the usage of the word "live" in ¶ 0063, which is used therein not to distinguish the living from the dead, but rather to distinguish mourners who are in attendance at a funeral from those who are not.

Turning to the precise language of the reference, Krim ¶ 0063 plainly states that

[s]urvivors of the deceased may establish an internet hookup and a digital video camera at the funeral, to make the proceedings available to any interested person over the internet. The person, conversely, may have a digital video camera or microphone so that the person may communicate with those at the live funeral, or may provide a prerecorded message, or may type words that will be shared with the live participants through an instant messaging service.

(emphasis added). Applicant submits that the only reasonable interpretation of "the person" in the quoted text is that it refers to the "any interested person" in the sentence

immediately preceding. This passage therefore refers not to the decedent's message, but to the participation of survivors who cannot attend the services.

Examiner, at page 3, also suggests that Krim ¶¶ 28-33 represent messages to be played at the funeral for attendees to see and hear. Again, Applicant cannot concur. Krim ¶ 28 states that messages "to be sent at death" (emphasis added) include:

- [0029] Friends, family, etc. to be notified of the member's death and funeral;
- [0030] Whether the member has will or living trust, and the location of the original document;
- [0031] Whether the member owns a life insurance policy, pension...or other account...and the location of any documents;
- [0032] Locations of any bank or securities accounts, safe deposit boxes, etc. and the location of any associated records;
- [0033] Any other important information about the family, such as photographs, heirlooms, etc.

(emphasis added).

The timing of the message is not insignificant, as Krim expressly teaches sending a message "at death". It is of course pure nonsense to play a notification of the death and funeral at the funeral, as attendees clearly received that information much earlier. Furthermore, whether a decedent has a will, a bank account, a safe deposit box or any other personal property or assets is not something that decedents or their executors and representatives would typically publish or disclose publicly at a funeral. To the contrary,

instructions regarding assets and personal property are often subject to a number of limitations on disclosure. In short, Krim teaches a notification function, not a mourning function, and as such Krim teaches away from Applicant's claimed invention.

As to Krim ¶¶ 37-38, while it is provided that the person may leave audio-visual materials to be delivered to designated individuals, Krim does not teach that this delivery occur at a funeral service. Owing to its notification function, Krim teaches a method by which persons may be notified of the decedent's passing in a manner selected by the decedent while living, utilizing Krim's disclosure. The timing and content of the personal notification can be pre-determined, but there is no teaching that it occur at the time of the funeral.

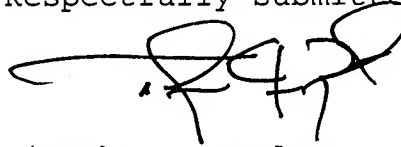
Krim does not disclose each of the limitations of Applicant's claim 1. Furthermore, Krim expressly teaches away from Applicant's disclosure. Pending claims 2-5 each depend from claim 1. For the reasons set forth herein, Applicant submits that the grounds for rejection have been removed, and respectfully requests that the rejection be withdrawn.

Conclusion

For the foregoing reasons, the Examiner has failed to make a prima facie case of anticipation in this application. Applicant respectfully requests that the rejection be withdrawn, and that claims 1-5 herein be allowed.

No other fees or extensions of time are believed to be due in connection with this response; however, consider this a request for any fee or extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'TJZ', with a long horizontal line extending to the left.

Timothy J. Zarley
Reg. No. 45,253
ZARLEY LAW FIRM, P.L.C
Capital Square
400 Locust Street, Suite 200
Des Moines, IA 50309-2350
Phone No. (515) 558-0200
Fax No. (515) 558-7790
Customer No. 34082
Attorneys of Record

TJZ/JRJ

Attachments: Appendices

VIII. Claims Appendix

What is claimed is:

1. A method of celebrating a person's life by attendees at a funeral after the person's death, comprising, causing the person, while alive, to create a message presentation that would welcome the attendee to the person's funeral and include personal comments to the attendee in a generally uplifting sense about the occasion of the funeral, storing the message presentation with instructions that the message presentation be played at the person's funeral, and publicly playing the message presentation at the person's funeral for the attendees at the funeral to see and hear.
2. The method of claim 1 wherein the message presentation is projected on a screen.
3. The method of claim 1 wherein the message presentation is an audio presentation.
4. The method of claim 2 wherein the message presentation is a combination video-type and audio presentation.
5. The method of claim 1 wherein the message presentation is an audio/video presentation.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None